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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,877	09/18/2003	Clement G. Eischen SR.	EIS 309	8893
23581	7590	08/08/2005	EXAMINER	
KOLISCH HARTWELL, P.C. 520 S.W. YAMHILL STREET SUITE 200 PORTLAND, OR 97204			ROANE, AARON F	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 08/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/666,877

Applicant(s)

EISCHEN, CLEMENT G.

Examiner

Aaron Roane

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 22 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 3739

## DETAILED ACTION

### *Central Fax*

On July 15, 2005, the Central FAX Number will change to **571-273-8300**.

Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number. To give customers time to adjust to the new Central FAX Number, faxes sent to the old number (703-872-9306) will be routed to the new number until September 15, 2005. (Note that since this new number is already operational, customers can use either number until September 15)

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 6-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Mintz (USPN 5,184,613).

Art Unit: 3739

Regarding claims 1 and 12, Mintz discloses a thermal pack apparatus (10), comprising: an enclosed shell having an outer panel (31) and an inner panel (30) sealed together at least around an outer perimeter (outer perimeter that comprises at least 50 and 51) and at least partially filled with a thermal material (12); wherein the thermal material is sealed within the shell and disposed between the outer and inner panels; wherein the shell includes opposing first and second ends (located near 50 and 51 respectively) spaced by first and second opposing sides (the left and right outer perimeters in figure 1); wherein the shell includes a first portion (upper portion in figure 1) and a second portion (lower portion in figure 1) separated from each other by a narrowed neck region formed by opposing substantially v-shaped notches (33 and 34) formed in the respective sides; wherein one notch is sized to enable the upper portion of the shell to form a first wrap configured to surround a limb on a first side of a joint and having opposing side segments adapted to fasten to each other when forming the first wrap; wherein the other notch is sized to enable the lower portion of the shell to form a second wrap configured to surround the limb on a second side of the joint and having opposing side segments adapted to fasten to each other when forming the second wrap; wherein the side segments of the first and second wraps are at least partially filled with the thermal material; and wherein the narrowed neck region is configured to act as a living hinge to enable flexing of the first wrap relative to the second wrap to thereby accommodate movement of the joint, see col. 2-7 and figures 1 and 2.

Art Unit: 3739

Regarding claims 2 and 3, Mintz discloses the claimed invention, see col. 6, lines 59-65.

Regarding claims 6 and 7, Mintz discloses side segments of both the first and second wrap that have a pair of fasteners (Velcro tab 14 and its opposing locking/fastening material for one wrap and Velcro tab 15 and its opposing locking/fastening material for the other wrap) positioned respectively on opposed sides (of the particular segment), the fasteners and the opposed side segments being configured to couple the opposed side segments to each other to surround the limb on both sides of the joint with thermal material, see col. 4-7 and figure 1.

Regarding claims 8-11, Mintz discloses notches capable of performing the recited intended use, see col. 2-7 and figures 1 and 2.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3739

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mintz (USPN 5,184,613) in view of Sheikh (USPN 6,589,272) and in further view of Cramer et al. (USPN 6,096,067).

Regarding claims 4 and 5, Mintz discloses the claimed invention except for explicitly reciting the thermal material is a silica gel. The examiner takes official notice of the recited silica gel and asserts that it is extremely well known in the art to use thermal gels containing silica in order to provide a material that transfers heat/cold to the patient for therapeutic purposes. Additionally and/or alternatively, Sheikh discloses a thermal device and teaches the use of a number of thermal agents/materials including gels, see claim 8. Cramer et al. disclose a thermal wrap (10) and teach a wide variety of materials that serve as thermal materials including silica gel, see col. 8, lines 4-50. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Mintz, as taught by Sheikh, to use a gel material in order to provide therapeutic heat transfer, and as further taught by Cramer et al., to use a wide variety of materials as thermal agents including gel silica.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 3739

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (571) 272-4771. The examiner can normally be reached on Monday-Thursday 7AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A.R.

*A.R.*

August 3, 2005

*Roy D. Gibson*

ROY D. GIBSON  
PRIMARY EXAMINER